RONUK LTD. v. SIN THYE HIN & CO.

[O. C. J. (Chua J.) August 23, 1962]

[Singapore — Originating Motion No. 4 of 1962]

Trade Marks — Removal from Register — Application for — Mark likely to deceive or cause confusion — "Panda" steel wool — Known amongst non-English speaking people as "Bear Brand" — Registration of "Bear Brand" steel wool — Whether in contravention of Trade Marks Ordinance (Cap. 185), s.15 — Expunging under s.39(1)(a) on grounds of wrongful registration and wrongly remaining on the Register.

The applicant is the registered proprietor of Trade Mark No. 9977 for the word "Panda" in respect of steel wool and steel shavings for cleaning purposes, registered some years before 1961 in Class 21 in Part A of the Register of Trade Marks. The applicant sought to remove from the Register the Trade Mark No. 28969 registered by the respondent. The mark in question consists of a combination device of the words "Bear Brand" and the figure of a bear and it was registered on July 27, 1961, in the same class, in respect of steel wool for cleaning purposes.

It was contended for the applicant that the respondent's mark should be expunged from the register under section 39(1)(a) of the Trade Marks Ordinance on the grounds that it was wrongly registered and that it wrongly remains on the register. The applicant urged: (1) the registration of the respondent's mark was in contravention of section 15 of the Ordinance that if the Registrar of Trade Marks had been aware of the considerations which are now before the Court he would have refused registration, and (2) the registration of the respondent's mark was in contravention of section 23 of the Ordinance.

The main contention of the respondent was that the respondent's mark does not so nearly resemble the applicant's mark as to be likely to deceive or cause confusion.

Held: (1) the burden of satisfying the court that the existence of the respondent's mark on the register is likely to deceive or cause confusion is upon the applicant. As there was uncontradicted evidence that on July 27, 1961, the applicant's "Panda" steel wool had been on sale in Singapore for five years and it had become known in the market amongst non-English speaking people as the "Bear Brand", there was at the date of registration a likelihood of confusion or deception that the Registrar would have refused registration had he been aware of all the circumstances. The applicant had discharged the onus upon it, and therefore was entitled to the relief sought;

(2) even if the respondent's mark was properly put on the Register, it had become calculated to deceive through the subsequent acts of the respondent by using a get-up in the packing of its product to confusingly similar to the get-up in the packing of the applicant's product.

MOTION.

J. E. Lloyd for the applicant.

F. B. de Souza for the respondent.

Cur. Adv. Vult.

Chua J.: This is an application by Ronuk Limited of Portslade, Sussex, England, to remove from the Register of Trade Marks the Trade Mark registered by Sin Thye Hin & Co., the respondent.

The Trade Mark in question is No. 28969 which consists of a combination device of the words "Bear Brand" and the figure of a bear and it was registered on the 27th July, 1961, in Class 21 in Part A of the Register of Trade Marks in respect of steel wool for cleaning purposes.

The applicant is the registered proprietor of Trade Mark No. 9977 for the word "Panda" in Class 21 in Part A of the Register of Trade Marks in respect of steel wool and steel shavings for cleaning purposes. There is no evidence as to when the applicant's mark was registered but it would appear that it was registered some years before 1961.

It is contended for the applicant that the respondent's mark should be expunged from the register under section 39(1)(a) of the Trade Marks Ordinance (Cap. 185) on the grounds that it was wrongly registered and that it wrongly remains on the register.

The applicant's evidence was given in two affidavits — one by Mr. T. F. C. Mills, the overseas sales executive, employed by Izal Overseas Limited, a company incorporated in the United Kingdom, which company is responsible for the marketing of the applicant's products outside the United Kingdom and the other by Madam Ha Niat Yin, a commercial assistant employed by J. L. Morison Son & Jones (Far East) Limited, the commercial agents of the applicant in Singapore and the person in charge of the sales of "Panda" products of the applicant.

The respondent's evidence was given in an affidavit by Tan Teng Lim, the sole proprietor of the respondent firm.

The evidence adduced by the applicant can shortly be summarised as follows. The sales of "Panda" steel wool manufactured by the applicant have been extremely extensive in Singapore and the value of the product imported into and sold in Singapore under this mark rose from $80,631 in 1956 to $251,510 in 1961. Madam Ha Niat Yin says: "Of my own personal knowledge I can say that 'Panda' steel wool is referred to in Malay as 'Chop Bruang' and in Chinese as 'Him' or 'Kow Him'. The respondent's newly introduced Bear Brand steel wool is referred to in Malay as 'Chop Bruang' and in Chinese as 'Him'. The Malay and Chinese words connote a bear, or type of bear." Mr. Mills drew attention to the many similarities between the applicant's "Panda Brand" pack and the respondent's "Bear Brand" pack.

The case presented for the applicant is first, that the registration of the respondent's mark is in contravention of section 15 of the Trade Marks Ordinance in that the use of the respondent's mark would by reason of its being likely to deceive or cause confusion or otherwise be disentitled to protection in a Court of Justice and that if the Registrar of Trade Marks had been aware of the considerations which are now before the Court he would have refused registration. Secondly, that the registration of the respondent's mark is in contravention of section 23 of the Ordinance in that it is registered in respect of some goods of a description which is identical with a trade mark belonging to a different proprietor which is already on the register in respect of the same goods or description of goods, or that it so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

The main contention of the respondent is that the respondent's mark does not so nearly resemble the applicant's mark as to be likely to deceive or cause confusion.

The burden of satisfying the Court that the existence of the respondent's mark on the register is likely to deceive or cause confusion is upon the applicant.

Now, the evidence is that by the 27th July, 1961, the "Panda" steel wool manufactured by the applicant has been on sale in Singapore for five years and it has become known in the Singapore market amongst the non-English speaking people as the "Bear Brand". This is the uncontradicted evidence of Madam Ha Niat Yin. It is clear that at the date of registration of the respondent's mark there was such a likelihood of confusion or deception that the Registrar would have refused registration under section 15 if he had been aware of all the circumstances. On this alone the applicant is entitled to succeed.

The applicant, however, further submitted that the respondent's mark is remaining wrongly on the register contrary to section 39(1)(a). It seems to me that even if the respondent's mark was properly put on the register, it has become calculated to deceive through the subsequent acts of the respondent by using a get-up in the packing of its product so confusingly similar to the get-up in the packing of the applicant's product. There is no doubt that, from the close similarities in the mark and get-up between the applicant's packing and the respondent's packing, the respondent's mark was chosen by them as being calculated to deceive. In my judgment the applicant has discharged the onus which is upon it to show that the mark of the respondent remains wrongly on the register.

For the reasons I have given, the applicant is entitled to the relief it seeks. There will be an order in terms of the motion. The respondent is to pay the costs of the applicant.

Order in terms.

Solicitors: *Drew & Napier; de Souza & de Souza.*

PUBLIC PROSECUTOR v. WAN HEE

[A. Cr. J. (Ong J.) August 1, 1962]

[K.L. — Criminal Appeal No. 29 of 1962]

Pawnbrokers — Receiving articles in pawn as security for loan — Interest — Pawnbrokers Enactment (Cap. 85), ss.2 and 3(ii) — Meaning of provisions of.

Moneylending — Receiving articles in pawn as security for loans — Obtaining promissory note and giving "collateral security" receipt for articles deposited — Moneylenders Ordinance, 1951, s.5 — Pawnbrokers Enactment (Cap. 85), ss.3 and 25.

The respondent, a licensed moneylender under section 5 of the Moneylenders Ordinance, carrying on business of moneylending under the name of Koon Sang Finance Co., on various dates received gold ornaments in pawn as security for loans of $75, $70 and $80 respectively advanced to three persons at the interest rate of 12% per annum and, instead of issuing the statutory form of pawnbroker's receipt, obtained from each borrower a promissory note for the amount lent which was expressed to be repayable "on demand six months after date", and gave to the borrower a receipt for the articles deposited "as collateral security" for the repayment of the loan. At the hearing before the learned Magistrate counsel's contention to the effect that nowhere in section 3 of the Pawnbrokers Enactment was it provided that a contravention of this section was an offence was upheld by the learned Magistrate.

Held: the penalty for contravention of section 3 of the Enactment was laid down in section 25 and the respondent was guilty of the offence of acting as a pawnbroker without a licence.

Observations on section 2 read as qualified by section 3(ii) of the Pawnbrokers Enactment.

MAGISTRATE'S CRIMINAL APPEAL.

H. S. Ong (Deputy Public Prosecutor) for the appellant.

S. D. K. Peddie for the respondent.

Cur. Adv. Vult.

Ong J.: This is an appeal by the Public Prosecutor against an order of the learned Magistrate, Kuala Lumpur, acquitting the respondent, at the close of the prosecution, on three charges of having, on three specified dates in 1960, acted as a pawnbroker without a licence granted under the Pawnbrokers Enactment in contravention of section 3 and punishable under section 25 of the Enactment.

The facts are not disputed. The respondent was at all relevant times a moneylender licensed, under section 5 of the Moneylenders Ordinance, 1951, to carry on the business of moneylending under the name of Koong Sang Finance Co. at No. 108 Brickfields Road, Kuala Lumpur. On various dates in 1960 he received gold ornaments in pawn as security for loans of $75, $70 and $80 respectively advanced to three persons at the interest rate of 12% per annum. Instead of issuing the statutory form of pawnbroker's receipt, the respondent obtained from each borrower a promissory note for the amount lent which was expressed to be repayable "on demand six months after date," and gave to the borrower a receipt for the articles deposited "as collateral security" for the repayment of the loan.

A preliminary objection on a point of law raised by Dato Rajasooria before the com-